

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID SKEDELESKI

Appeal No. 98-2946
Application 08/291,596¹

ON BRIEF

Before CALVERT, MEISTER and CRAWFORD, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 9 to 13, 15, 16 and 21. Claims 3 to 6, 8 and 22 to 24, the other claims remaining in the application, have been allowed.

The claims on appeal are drawn to a snowboard with protective tip cover, and are reproduced in the appendix to appellant's brief.

¹ Application for patent filed August 16, 1994.

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The references applied in the final rejection are:

Joyce	3,374,495	Mar. 26, 1968
Wiig	5,320,378	Jun. 14, 1994

Pellethane® Polyurethane Elastomers, Typical Physical Properties (Dow Chemical Co., 4 pages)[1992] (Pellethane brochure)

The claims on appeal stand finally rejected as unpatentable under 35 U.S.C. § 103(a) over the following combinations of references:

- (1) Claims 1 and 9 to 11, Wiig in view of Joyce;
- (2) Claims 1, 9 to 13, 15, 16 and 21, Wiig in view of Joyce and the Pellethane brochure.

This is the second appeal in this application. In our decision on the first appeal (Paper No. 23, June 18, 1997), we, inter alia, affirmed the rejection of claims 1 and 9 to 11 on ground (1), supra, and entered two new rejections pursuant to

37 CFR 1.196(b), one of which was the rejection which is now under consideration in this appeal as rejection (2).

Following the decision, appellant filed an amendment which included an amendment of claim 1, the only independent claim involved in the present appeal, and submitted declarations by

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the appellant, David Skedelecki, as well as by James Vermillion, Jon Bruggeman and Harry Martin.

On pages 13 to 18 of his brief, appellant argues that the claimed subject matter would not have been prima facie obvious over grounds of rejection (1) and (2). We disagree, essentially for the reasons stated in our decision, Paper No. 23. While snowboards and surfboards may be "different products with different problems" (brief, page 14), it appears that they would have the common problem of damage due to collision (impact) and abrasion. In our view, one of ordinary skill seeking to solve this problem with regard to snowboards would have found in Joyce's disclosure a suggestion of how to solve the problem. The fact that surfboards may not be subject to delamination, as snowboards are, is not persuasive of unobviousness for the reasons stated on pages 7 and 8 of Paper No. 23.

With regard to the recitation in claim 1 that the tip cover has an arcuate extent of about 150°-190°, we held that the extent of coverage would have been an obvious matter, appellant not having shown that it was critical, citing In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed.

Cir. 1990)(Paper No. 23, page 11). We made a similar holding concerning the number, location and angle of the V-shaped cutouts recited in claims 10 and 11 (*id.*, pages 15 and 16).

Appellant argues on pages 15 and 16 of the brief that our approach with regard to criticality was erroneous as a matter of law, citing In re Bertin, 324 F.2d 182, 185, 139 USPQ 275, 277 (CCPA 1963). However, Bertin concerned a situation in which the prior art did not disclose a claimed structural feature, namely, a helical arrangement of nozzles. By contrast, in the present case, the prior art (Joyce) discloses the claimed structural features in question, i.e., a tip cover having an arcuate extent and V-shaped cutouts; the difference between the claimed invention and the prior art is, as stated in In re Woodruff, "some range or other variable within the claims" (*id.*). We therefore consider that our findings of obviousness (non-criticality) with regard to the claimed range of arcuate extent and details of the V-shaped cutouts were correct.

Having determined that a prima facie case of obviousness exists, we now consider, as in our decision (Paper No. 23, pages 12 to 15), whether the prima facie case is rebutted by

the evidence submitted by appellant.² Appellant asserts that the evidence (declarations) establishes commercial success, and even if it does not, it shows a long felt need in the art that is solved by the claimed invention (brief, page 6). In the final rejection (Paper No. 27), the examiner found the declarations of appellant, Vermillion, Bruggeman and Martin to be insufficient to overcome the rejection³ because they failed to establish (1) a nexus between the claimed invention and evidence of commercial success, (2) a long-felt need, and (3) actual commercial success.

We first consider the declaration of appellant, who is the president of Surfco Hawaii, a company that sells Nose Guard® protective tips for surfboards and snowboards. Appellant states that ever since snowboards were first sold in the United States there has been a problem of delamination due to impact. He further states in paragraph 3:

3. Despite the fact that snowboards have been sold commercially in the United States since at least 1978, no one heretofore solved the problem of

² This evidence consists of the four declarations noted above, as well as the previously filed declarations of the ten persons listed in Paper No. 23, page 12, n.5.

³ Although he only referred to rejection (2), the examiner presumably also intended to include rejection (1) in his finding.

delamination. Attempts have been made, but those attempts have not been successful. For example snowboard manufacturers have added aluminum plates and/or rivets to the nose and tail portions of the snowboard. Those techniques did not solve the delamination problem, although it helped to minimize the problem, and those techniques have added excess weight which appears to adversely affect the performance of the boards. Also the addition of the metal components is expensive. As a result a number of snowboard manufacturers who at one time used aluminum plates on the noses of snowboards have now stopped using them.

Appellant then states that the Nose Guard® snowboard tips sold by Surfco Hawaii are illustrated in Figs. 1 to 7 of his application, and have solved the delamination problem. With regard to sales, paragraph 6 of appellant's declaration states:

6. Since Surfco Hawaii started to sell Nose Guard® protective tips covered by the claims of this application (see Exhibit B) in about November of 1994, the total sales have been \$65,099 (which is 10,850 actual pieces). This is despite the fact that the product was introduced from scratch, to a market that had never seen another product like it, and despite the fact that Surfco Hawaii did not have longstanding or significant contacts in the snowboard trade, and is a small company with only ten employees without experience in marketing to snowboarders. The total expenditure for advertising in this time period was \$8,604.45, which was primarily directed to getting the public exposed to this new product. Sales have continuously increased since introduction for each winter season, and the sales have been as a result of the product being able to perform as designed -- namely to prevent

delamination while not adversely affecting the board performance -- and not because of any marketing campaign on Surfco's part. For example the three most recent distributors that I have signed up to market the Nose Guard® protective tips for snowboards (whose declarations are being submitted separately) have all indicated to me that the reason that they decided to handle the product is because it solves the delamination problem without adversely affecting board performance, not because of marketing hype, or any other reason.

The declarations of Vermillion, Bruggeman and Martin are similar in content. Each declarant is the owner of a company which markets winter sports equipment, including snowboards. Each decided to start selling Nose Guard® snowboard protective tips because they solve the nose delamination problem, and there is a need in the marketplace for such a product. Vermillion states that "there is nothing on the market [other than Nose Guard®] that I am aware of that can properly solve the delamination problem" (para. 3), and according to Martin, "Although my company has been selling equipment for snowboards since 1988 I have not seen any other product that is capable of preventing delamination" (para. 3). Bruggeman agrees with appellant that prior attempts to solve the delamination problem were not effective (para. 2):

I am familiar with prior attempts to solve the delamination problem such as by utilizing aluminum,

or other metal, tips for the boards, but these other attempts have not effectively solved the problem and most manufacturers no longer use metal tips. The metal tips add undesired weight to the board, and simply don't adequately protect the nose if the snowboard runs into certain objects.

Considering appellant's evidence as a whole, we do not view it as sufficient to show commercial success of the invention. Assuming there to be a nexus between the sales reported in paragraph 6 of appellant's declaration, supra, and the invention, "evidence related solely to the number of units sold provides a very weak showing of commercial success, if any." In re Huang, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). However, considering the evidence of sales in conjunction with the other evidence discussed above, we conclude that appellant has established that the claimed invention filled a long-felt need in the snowboard field. Evaluating the evidence in light of the factors considered by the court in Radix Corp. v. Samuels, 13 USPQ2d 1689, 1695 (D.D.C. 1989), appellant has shown (1) there was a need for a solution to the delamination problem since snowboards were first sold in the United States from at least 1978; (2) the attempts of others to solve the problem, by using metal plates and/or rivets, did not effectively solve the problem; (3) all

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or most manufacturers who used metal tips no longer use them;
and (4) the claimed device solves the problem. Accordingly,
the evidence herein overcomes the prima facie case of
obviousness, and rejections (1) and (2) will not be sustained.

Conclusion

The examiner's decision to reject claims 1, 9 to 13, 15,
16 and 21 is reversed.

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Reversed

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES M. MEISTER)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

IAC/kis
NIXON & VANDERHYE
1100 N. Glebe Road
Eighth Floor

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Arlington, VA 22201-4714